

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/626,099 07/26/00 XING

L

EXAMINER

HM12/0713

LIN, J

LAURENCE A WEINBERGER
882 S MATLACK ST. SUITE 103
P O BOX 1663
WEST CHESTER PA 19380-0053

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

07/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/626,099

Applicant(s)

XING ET AL.

Examiner

Jerry Lin

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

DETAILED ACTION

Drawings

1. Applicant is hereby notified that the required timing for the correction of drawings has changed. See the last 6 lines on the sheet, which is attached, entitled "Attachment for PTO-948 (Rev. 03/01 or earlier)." Due to the above notification Applicant is required to submit drawing corrections within the time period set for responding to this office action. Failure to respond to the requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

Claim Objections

2. Claim 1 is objected to because of the following informalities: periods are found within the claim. Periods should only be placed after the claim number and at the end of the claim. Appropriate correction is required.

Also in instant claim 1, the acronym "PLS" is found in line 11. The acronym should be defined in the instant claim.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In instant claim 1, the claimed invention is

drawn to collecting known pK_a for ionizable groups on a molecule followed by a mathematical method. The remainder of the instant claims is a standard prior art process of storing data in a database. Thus the invention in this instant application is the "mathematical" steps per se used to determine the pK_a . Mathematical inventions per se are not statutory and are unpatentable. It is acknowledged that data collection is recited in instant claim 1, however mere data collection followed by a mathematical invention is still non-statutory.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin *et al.* (Book of Abstracts, COMP-149).

Martin *et al.* disclose a method of predicting pK_a . Martin *et al.* utilizes the Comparative Molecular Field Analysis (CoMFA) 3D QSAR method to determine the activity coefficients and subsequently the pK_a of various ionizable groups at each level. The interaction energies of the molecule of interest and its environment is also determined. Then a Partial Least Squares methodology is used to find the final pK_a of the molecule of interest.

However, Martin *et al.* does not teach storing the data in a database.

It would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to store the data from Martin *et al.*'s method into a database. It well known in the art that several software applications can be used for computational chemistry, such as SYBYL (see applicant's specification, p. 6, lines 10-22). Such programs come with the capability of storing data into a database. "In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (. . . . The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.)."(See MPEP 2144.04). Thus one would be motivated to practice Martin *et al.*'s method with a common software application with a data saving function for the ease of use or since it is common practice to use software over hand written calculations.

No claim is allowed.

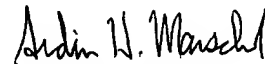
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Lin whose telephone number is (703) 306-5439. The examiner can normally be reached on 8:00am-4:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (703) 308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tracey Johnson, whose telephone number is (703) 305-2982 or to the Technical Center receptionist whose telephone number is (703) 308-0196.



Jerry Lin
July 12, 2001


ARDIN H. MARSCHEL
PRIMARY EXAMINER